

RESPONSE

Objections and Rejections

The Examiner has rejected claims 1-13, 15-22 and 24-25 under 35 U.S.C. 112, second paragraph for indefiniteness and claim 12 under 35 U.S.C. 112, first paragraph for failure to comply with the written description requirement. Applicants have amended the claims as follows:

Claim 1 has been amended to make it clear the emulsifier present comprises one or more surfactants and the emulsifier's HLB, which is the overall HLB of the surfactant or surfactants that make up the emulsifier, is less than 9. The surfactant or surfactants that may comprise the emulsifier are selected from the group consisting of (i) through (xi). The use of "including but not limited to... and the like" has been removed from (i) of claim 1. Support for these amendments is given on page 12, lines 4-13. Claim 1 has also been amended to include the limitations of Claims 3 and 4.

Claim 2 has been amended by removing the term "thickeners" from the list of additional components that may further comprise the emulsion composition.

Claim 3 has been canceled.

Claim 4 has been canceled.

Claim 5 has been amended to correct the improper Markush group with regard to the water soluble salts.

Claim 9 has been amended to address the lack of antecedent basis for the term "the oil soluble detergents."

Claim 12 has been amended to make clear that the functionalized copolymers and terpolymers referred to in the claim include the reaction product of copolymers and terpolymers with maleic anhydride.

Claim 17 has been amended such that it now refers to the "emulsifier" (singular) as opposed to "emulsifiers" (plural).

Claim 18 has been amended to specify that the molecular weight included is a number average molecular weight, with support for this amendment on page 16, line 5 of the specification.

Claim 21 has been canceled.

Claim 22 has been amended to make it clear that the emulsifier used in the claimed process has an overall HLB of less than 9, whether the emulsifier is made up of one or more surfactants. Claim 24 has also been amended to include the limitations of claim 24.

Claim 24 has been canceled.

Claim 25 amended to incorporate the limitations of claim 21, which has been cancelled.

In view of the amendments made to the claims, the 35 U.S.C 112 objections and rejections are obviated.

Double Patenting Rejections

The Examiner has rejected claims 1-11, 19, 20-22 and 24 on the grounds of non-statutory obviousness-type double patenting over claims 1-19 of Manka (US 6,933,263).

Applicants hereby state that this patent application and the above identified reference have been and are commonly owned at the time of the invention and when this application was made. Further, Applicants have filed a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) with this amendment to overcome the double patenting rejection. Accordingly, these rejections should be removed.

U.S.C. 102(e) and 103(a) Rejections

The Examiner has rejected claims 1-2, 4-5, 16, 18-20, 22 and 25 as being anticipated by Pollack (US 2003/0019552) under 102(e). The Examiner also rejected claims 17, 18 and 24 under 103(a) as obvious over Pollack. The Examiner is of the position that claims 3, 6-15, 17, 21 and 24 are not anticipated by Pollack.

Applicants have amended claim 1 by incorporating the limitations of claim 3, which is now cancelled. Claim 3 was not anticipated by Pollack. Therefore the currently amended claim 1 should not be anticipated by Pollack. The 102(e) rejections of claims 1-11, 19, 20 and 25 should be removed.

Applicants have also incorporated the limitations of claim 24 into claim 22. Claim 24, which is now cancelled, was not anticipated by Pollack. Therefore the currently amended claim 22 should not be anticipated by Pollack. The 102(e) rejection of claim 22 should be removed.

Furthermore, Applicants hereby state that this patent application and the above identified reference have been and are commonly owned at the time of the invention and when this application was made. This application and Pollack are assigned to The Lubrizol Corporation. Therefore, this precludes rejections under 35 U.S.C. 103(a) based upon the commonly assigned case and under 35 U.S.C. 102(e), (f) and (g). Further, Applicants have filed a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) to overcome any actual or

provisional rejection for double patenting, as the patent application is shown to be commonly owned with this application. Accordingly, these rejections should be removed.

The Examiner has rejected claims 1-13, 15-16, 18-22 and 25 as being anticipated by Filippini (US 2004/0176263) in view of the evidence in The Kirk-Othmer Encyclopaedia of Chemical Technology under 102(e). The Examiner also rejected claims 3, 17, 18 and 24 under 103(a) as obvious over Filippini. The Examiner is of the position that claims 17 and 24 are not anticipated by Filippini.

Applicants have amended claim 1 by incorporating the limitations of claim 3, which is now cancelled. These limitations require the viscosity of the claimed emulsified composition to be in the range of about 200 to about 2,000,000 cPs measured on a Brookfield Viscometer with a No. 7 spindle at 20 rpm at 25°C. As the Examiner notes, this limitation is not taught or suggested by Filippini. Filippini discloses a possible viscosity range as measured on a Brookfield Viscometer with a No. 3 spindle at 10 rpm at 25°C. These differences in spindle size and rpm make the comparison of Brookfield viscosity results improper as it is known in the field that differences in these conditions result in significantly different viscosity measurements. As Applicants' required viscosity range is not disclosed, taught or suggested by Filippini, the reference cannot anticipate or make obvious Applicants' claimed invention. Therefore the 102(e) rejections should be removed.

In addition, Applicants have amended claim 1 by incorporating the limitations of claim 4, which is now cancelled. These limitations require the oil used in the compositions to be natural oils, synthetic oils, alkylene oxide polymers, esters of dicarboxylic acids, unrefined oils, refined oils, re-refined oils, waxes, oil of lubricating viscosity or combinations thereof. Filippini discloses an emulsified composition that includes a solvent as the organic phase. The list of possible solvents, described in paragraphs [0031] to [0052] of the reference, does not include the oils required by Applicants' invention. The Examiner notes that paragraph [0137] of the reference indicates a diluent such as mineral oil, kerosene, synthetic oil and esters of carboxylic acids may be present as well. Applicants point out that paragraph [0137] of the reference is referring to the surfactant and, more specifically, an additive concentrate mixture of the surfactant and a diluent, not an emulsion composition. The reference explains this diluent may be one of the solvents it describes as component (A), or it may be one of the other materials listed in the paragraph, including mineral oil and synthetic oil. Therefore mineral oils, synthetic oils and similar materials, such as those required by Applicants' invention, are not included in the component (A) solvent described in Filippini. As the oil used in the emulsion composition required by Applicants' invention is not disclosed, taught

or suggested by Filippini, the reference does not anticipate or make obvious Applicants' invention. The 102(e) rejections should be removed.

Applicants have incorporated the limitations of claim 24 into claim 22. Claim 24, which is now cancelled, was not anticipated by Filippini. Therefore the currently amended claim 22 should not be anticipated by Filippini. The 102(e) rejection of claim 22 should be removed.

Furthermore, Applicants hereby state that this patent application and the above identified reference have been and are commonly owned at the time of the invention and when the application was made. The application and Filippini are assigned to The Lubrizol Corporation. Therefore, this precludes rejections under 35 U.S.C. 103(a) based upon the commonly assigned case and under 35 U.S.C. 102(e), (f) and (g). Further, Applicants have filed a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) to overcome any actual or provisional rejection for double patenting, as the patent application is shown to be commonly owned with this application. Accordingly, these rejections should be removed.

In view of the foregoing amendment and remarks, Applicants respectfully request allowance of all of the claims in the application. If for any reason the Examiner believes a telephone conference would expedite the prosecution of this application, I can be reached at the telephone number listed below.

If any fees are due, the Commissioner is authorized to charge such fee to our Deposit Account No. 12-2275.

Respectfully submitted,

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